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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,682	09/12/2003	Jeff P. Whetman	2003P03157US	7359

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Siemens Corporation  
Intellectual Property Department  
170 Wood Avenue South  
Iselin, NJ 08830

EXAMINER
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DANNEMAN, PAUL

ART UNIT	PAPER NUMBER
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3627

MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/661,682	<b>Applicant(s)</b> WHETMAN ET AL.	
	<b>Examiner</b> PAUL DANNEMAN	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 25-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12 September 2003</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. **Claims 1-24**, drawn to a Tool Database indicating location, assignee, and condition of the tool, classified in class 705, subclass 28.
  - II. **Claims 25-33**, drawn to Proper tool usage in sequential activities, correction of improper tool usage and calibration of the tool, classified in class 702, subclass 182.
2. The inventions are distinct, each from the other because of the following reasons:
3. **Inventions I, and II** are related as subcombinations disclosed as usable together in a single combination. **Invention I** is drawn to a method and system for assigning tools to different locations and / or personnel with an indication of the condition of the tool (available for checkout, checked out to assignee / location and the condition of the tool). **Invention II** is directed to the proper usage of tools in sequential activities, the correction of deficiencies introduced by improper tool usage and / or usage of a tool which is out of calibration. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination are separately usable. See MPEP § 806.05(d).
4. The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claims(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFS 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional and / or nonstatutory double patenting rejections over the claims of the instant application.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner, if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification thereby requiring a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.
6. **Election by Telephone:** During a telephone conversation with John Musone, Registration Number 44961 on 11 January 2008 a provisional election was made without traverse to prosecute the invention of the elected group, Claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### **Status of Claims**

1. This is in response to the application filed on 12 September 2003.
2. Claims 1-24 have been examined.
3. Claims 25-33 have been withdrawn from further consideration.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 1-22 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracker.

7. **Examiner's note:** Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1-7, 9-15, 20-22, and 24:**

With regard to the limitations:

- ***Tool Inventory Database accessible over a network.***
- ***Quantity, Location and Condition of tools and to whom they are assigned contained within the database.***
- ***Electronic tool ordering / requesting.***
- ***Creating a shipping document for the requested tool.***
- ***Billing for tools that are loaned out.***

Tracker in at least page 1, paragraph [1] discloses a construction tool, inventory, and equipment tracking software package and equates the package to being similar to a computer system in a public library. Tracker in at least page 12-13, paragraph [all] discloses tracking the tool assignee and location, and in at least page 6, paragraph [3-4] when the tool was checked-out and when the tool was returned to the tool repository. Tracker in at least page 23, paragraph [3] further discloses the software package installed on a network with multi-user capability. Tracker still further discloses optional Tracker modules for specialized needs like billing for tool sales and rentals (in at least page 17, paragraph [2], and page 18-20, paragraph [all]), preventive maintenance and repair cost tracking (in at least page 21-23, paragraph [all]), small tool and consumables tracking and shipment (in at least page 14, paragraph [2], and page 15, paragraph [all]). Tracker in at least page 6, paragraph [2] still further discloses a shipping tag or document for tools being shipped to a job or storage site. Therefore it would be obvious, at the time of the invention, to one of ordinary skill to conclude that Tracker's features are functionally equivalent to applicant's regarding the numerous uses of a Tool Inventory Database.

**Claims 8, 16-19:**

With regard to the limitations:

- ***Ordering a requested tool when it is not available in the database.***
- ***Updating database to indicate the order status and availability of a tool.***

Tracker does not specifically disclose the limitation where a request for a tool, not available in the database generates a vendor order for the requested tool per se. However, Tracker in at least page 8, paragraph [1] discloses the use of a pick ticket used to process tool orders. Backorders are printed for pick tickets with unfilled items when the order is processed. Tracker in at least page 15, paragraphs [2-4] discloses a tool purchase order system coupled to the tool inventory and in paragraph [7] further discloses a purchase order tracking feature and discloses that the purchase order is more like an "Add to stock" function. Therefore, it would be obvious, at the time of the invention, to one of ordinary skill to conclude that Tracker's backorder which is triggered

from an unfilled pick ticket and the purchase order system are equivalent to the Applicant's limitations.

8. **Claim 23** rejected under 35 U.S.C. 103(a) as being unpatentable over Tracker as applied to **claim 13** above, and further in view of Brockwell et al., henceforth known as Brockwell.

**Claim 23:**

With regard to the limitations:

- ***Bill of lading for tool shipments containing data of a Schedule B.***
- ***Export Classification Number.***
- ***Harmonized Tariff Schedule.***

Tracker does not specifically disclose a bill of lading. However, Tracker in at least page 6, paragraph [2] discloses a shipping tag or document for tools being shipped to a job or storage site. Brockwell in at least Column 4, lines 25-31, Fig.4 and Fig.11, discloses a packaging system for handling the shipment of packages domestically and internationally. Brockwell in at least Column 5, lines 10-17, Fig.2b and Column 6, lines 4-18 discloses the use of classification codes such as the Harmonized Tariff Classification Code. Therefore, it would be obvious, at the time of the invention to modify Tracker's shipment document with the international shipment features of Brockwell to allow parts to be shipped in a timely and efficient manner wherever the job site is located.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- Allen, US 6,840,451 B2 teaches a method of tracking a large number of tools.

Art Unit: 3627

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

12 January 2008

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627